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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,890	05/14/1999	JAMES H. SABRY	19681-2	1859

22434 7590 06/30/2003

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

34

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,890

Applicant(s)

Sabry et al.

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/12/02 and 4/3/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-18 and 45-57 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18 and 45-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 33
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicants' arguments, filed 11/12/02 and 4/3/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

NEW MATTER

Claims 16-18 and 45-57 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 has been amended to indicate that the liquid light guide comprises a flexible "hose-type sleeve wherein said sleeve is filled...". Consideration of the written support pointed to by applicants on page 16 reveals that the flexible hose type sleeve "is" the light guide as disclosed on page 16, lines 6-7, wherein the sleeve is filled with a liquid such as.... This disclosure does not include the broadening concept that the light guide "comprises" such a flexible hose type sleeve. The specification at page 16, lines 2-5, as filed, supports the previous form of claim 16 wherein the light guide is selected to

have (open wording equivalent to comprises) a flexible member. This, however, does not support the present claim wording wherein the light guide comprises a flexible hose sleeve... vs. the light guide "is" (closed wording equivalent to consists of) a flexible hose-type sleeve as set forth on page 16, lines 6-8, which is clearly a more limited version of the light guide. This difference in description in claim 16 as now present vs. the specification as summarized above is NEW MATTER. This rejection is necessitated by amendment. This rejection also applies to claims directly or indirectly dependent from claim 16 due to their dependence.

Claim 50 generically cites a "less than 30% transmission loss" without further limitation. Consideration of the support pointed to by applicants on page 16 of the specification reveals that the less than 30% transmission loss is specifically evaluated "at a remote location such as the imaging system" in line 14. This is a more limited description of the transmission loss than what is now present in claim 50. Therefore, the broadening over the page 16, line 14, loss limitation is NEW MATTER in that the remote location such as an imaging system location limitation is not present in claim 50. This rejection is necessitated by amendment.

Claim 52 cites a "stage comprising a device for moving the cells". No such disclosure has been found on page 16 as pointed

to by applicants. Consideration of the remainder of the specification reveals that a stage X-Y and Z movement disclosure is set forth in the specification on page 14, lines 11-34, as the closest stage disclosure to claim 52. This disclosure, however, lacks any description of an additional "device for moving the cells". Therefore such a device added to the stage via the phrase "stage comprising a device..." as noted above is NEW MATTER. This rejection is necessitated by amendment.

Claim 55 cites a filter wheel with filters "each filtering for a different color". The closest description as filed is in the specification on page 15, lines 25-33, which describes a filter wheel with a plurality of filters, but does not describe the above phrase "each filtering for a different color". This filtering of each filter for a different color therefore is NEW MATTER. This rejection is necessitated by amendment.

Claim 57 cites "software for creating and sequentially naming files of the information". This creation and sequential naming of files has not been found as filed on said page 16 as pointed to by applicants nor elsewhere in the instant disclosure as filed. The above phrase is therefore NEW MATTER. This rejection is necessitated by amendment.

PRIOR ART REJECTIONS:

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 16-18 and 52-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hemstreet, III et al. (P/N 5,733,721); taken in view of Sutherland et al. (P/N 4,818,710).

This rejection is reiterated from the previous office action, mailed 10/00/02, and as necessitated by amendment regarding newly added claims as listed as rejected above. Applicants argue that the flexible member light guide in the claims distinguishes the instant invention over the above listed combination of references. In response the oil-filled reservoir as pointed to in Sutherland et al. in the previous two office actions is clearly flexible as well as providing vibrational isolation as required in the instant claims. Thus, this argument

is non-persuasive. Claims 52-56 are additionally rejected hereinunder due to the system components as software control as shown in Figure 13 of Hemstreet, III, et al.

The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See the hyperlinks in the specification on page 36, lines 30 and 31, and page 47, line 14.

Appropriate correction is required.

No claim is allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

June 26, 2003


ARDIN H. MARSCHEL
PRIMARY EXAMINER